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| 09/760,864 | 01/16/2001 | Mika Partain | 2271/63926 | 4206 |
| <div>7590 07/23/2008</div> <div>Ivan S. Kavrukov Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036</div> <div>EXAMINER DESHPANDE, KALYAN K</div> <div>ART UNIT 3625 PAPER NUMBER</div> <div>MAIL DATE 07/23/2008 DELIVERY MODE PAPER</div> | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/760,864

Applicant(s)

PARTAIN ET AL.

Examiner

Kalyan K. Deshpande

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25, 27-29 and 45-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25, 27-29 and 45-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Prosecution History Summary

- Claims 1-22 and 41 have been canceled.
- Claims 23-24, 26, and 30-44 have been cancelled.
- Claims 25, 27-29, and 45-60 are currently pending in the instant application.

Response to Amendments

Applicants' amendments to claims 25 and 27-29 are acknowledged. Applicants' cancellation of claims 24, 26, and 30-44 is acknowledged. New claims 45-60 are acknowledged.

Response to Arguments

Applicant's arguments filed April 1, 2008 have been fully considered but they are not persuasive. Applicants' argue 1) Mesaros teaches away from the present invention because Mesaros does not teach costing schemes involving any transactions (see Remarks p. 14), 2) Mesaros fails to teach "display of promotion information" (see Remarks p. 15), and 3) Mesaros fails to teach a minimum quantity range (see Remarks p. 16).

In response to Applicants' argument Mesaros teaches away from the present invention because Mesaros does not teach costing schemes involving any transactions (see Remarks p. 14), Examiner respectfully disagrees. Mesaros clearly teaches costing schemes (see Mesaros figure 4). Applicants appear to be summarizing limited portions of Mesaros and reading the summaries in a vacuum to draw this conclusion. For example, Applicants' are citing Mesaros background description and using Mesaros

stated goals as achievements not yet done, whereas Mesaros clearly attempts to solve the problems and achieve the goals set forth. As such, Examiner maintains Mesaros does not teach away from the present invention and expressly reads on the recited claims.

In response to Applicants' argument Mesaros fails to teach "display of promotion information" (see Remarks p. 15), Examiner respectfully disagrees. Mesaros explicitly teaches this where in figures 4 and 13 Mesaros teaches a displaying promotion information "189" and "190". This offer range is the same as a promotion.

In response to Applicants' argument Mesaros fails to teach a minimum quantity range (see Remarks p. 16), Examiner respectfully disagrees. In Mesaros' figure 4, minimum quantity for each pricing tier is disclosed. Examiner is unclear as to why Applicants are citing the portions of Mesaros they are and how they allegedly contradict the teachings of figure 4. As such, Examiner maintains that figures 4, 13 and 14 directly read on this limitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25, 27-29, and 45-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mesaros (U.S. Patent No. 7,124,099) in view of Rubin (U.S. Patent No. 6,078,897).

Referring to claim 25, Mesaros teaches "a method for enhancing product sales in Internet transactions, the method comprising: delivering display information to a customer side for ordering products via the Internet" (Mesaros: column 7, lines 8-9 and figure 2), "receiving at a seller side an initial order entered at the customer side for a specified product and a specified quantity" (Mesaros: column 7, lines 8-9 and figure 2), "comparing the specified quantity of the initial order, placed by the customer side to the seller side, to a first predetermined quantity" (Mesaro: figure 4; where ranges of quantity are offered different prices. For example, between 101-200 is one range (where 101 is a first predetermined quantity and 200 is a second predetermined quantity).), "changing the display information to be delivered to the customer side in accordance with the specified quantity of the specified product" (Mesaro: figure 4), "wherein if the specified quantity of the specified product is within a first range that is lower than the first predetermined quantity but higher than a second predetermined quantity, display information indicative of at least a first promotion, corresponding to a retail sales

transaction, which is functionally related to the initial order is delivered to the customer side" (Mesaro: figures 4, 13 and 14; where ranges of quantity are offered different prices. For example, between 101-200 is one range (where 101 is a first predetermined quantity and 200 is a second predetermined quantity).), "if the specified quantity of the specified product is in a second range higher than the first range, display information indicative of at least a second promotion corresponding to a business to business transaction, that is different from the first promotion is delivered to the customer side" (Mesaro: figures 4, 13 and 14), and "if the specified quantity of the specified product is less than the second predetermined quantity, order processing information is delivered to the customer side for the initial order and no promotion information is delivered to the customer side" (Mesaro: figures 4, 13, and 14). Mesaro fails to explicitly teach "and is contingent on a revision of the order to increase the specified quantity to said first predetermined quantity". Mesaros does not expressly disclose a method wherein a promotion is contingent on a revision of an initial order by a customer to make an additional purchase. Rubin discloses a method wherein a promotion is contingent on a revision of an initial order by a customer to make an additional purchase (Rubin: Abstract, "The user can add one or more additional orders to the proposed order, and then submit the new proposed order."). At the time of invention it would have been obvious to one of ordinary skill in the art to have modified the method of Mesaros to incorporate the promotion scheme of Rubin because of the complexity of some discount structures a consumer may not be aware at the time of an order that a moderately

larger order can increase a discount available (Rubin: column 1, line 65 to column 2, line 17).

Mesaros also does not expressly disclose changing display information to be delivered to the customer said in accordance with the specified quantity of the specified product. Rubin teaches this (Rubin: column 4, lines 55-65). Rubin discloses a method wherein least expensive additional order calculator 232 divides the additional volume by the volume contribution of each product having a vendor equal to the vendor identified in the proposed order stored in proposed order storage 212. For each product, the result of this division is rounded up and the rounded result multiplied by the price of the product to produce an extended price. One or more of the minimum extended prices is selected and the corresponding product identifier, quantity and total price is provided by least expensive additional order calculator 232 to administration 250 for presentation to the user. At the time of invention it would have been obvious to one of ordinary skill in the art to have modified the method of Mesaros to incorporate the promotion scheme of Rubin because of the complexity of some discount structures a consumer may not be aware at the time of an order that a moderately larger order can increase a discount available (Rubin: column 1, line 65 to column 2, line 17).

Referring to claim 27. Mesaros further discloses a method wherein the display information indicative of a first promotion includes information regarding a difference between the initial order quantity and a quantity for qualifying for the first promotion (Mesaros: Fig. 4, “188” and “189”).

Referring to claim 28. Mesaros discloses wherein the first promotion includes providing without charge one or more products different from the specified product (Mesaros: figure 8). The Examiner notes, the "wherein" clause of claim 28 merely states the result of the limitation in the claim. The wherein clause does not relate back to or clarifies what is required by the claim and is therefore given little patentable weight. See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001).

Referring to claim 29. Mesaros further discloses a method wherein the customer side and seller side are at geographical remote locations (Mesaros: Fig. 1).

Referring to claims 45, 52, and 58, claims 45, 52, and 58 recites limitations already addressed by the rejection of claims 25 and 27-29; therefore the same rejections apply to this claim. Claims 52 and 58 further recites a system (taught by Mesaros, see Mesaros abstract).

Referring to claim 46 and 60, claim 46 recites limitations already addressed by the rejection of claims 25 and 27-29; therefore the same rejections apply to this claim (where modifying is the same as revising).

Referring to claim 47, 49, and 59, Mesaros and Rubin fail to explicitly teach "wherein if the customer side confirms the initial order without modifying the initial order, the seller side determines that the initial order does not qualify as a retail-customer-to-business transaction", "wherein if the customer side confirms the initial order without modifying the initial order, the seller side determines the transaction does not qualify as the business-to-business transaction", and "wherein said determination part determines that the initial order is a business to business transaction based on the identity of the customer". Examiner takes Official Notice that it is old and well-known in the art to have these features. It would have been obvious, at the time of the invention, to one ordinary skill in the art to modify Mesaros to include features that describe the transactions and orders based on whether the customer confirms the order without revising or based on the identity of the customer, rendering the order as not a retail-customer-to-business transaction and the transaction not as a business-to-business transaction, in order to enhance customer relationship management.

Referring to claim 48, Mesaros teaches "wherein when the specified quantity of the initial order is greater than said first predetermined quantity but less than said third predetermined quantity, the seller side calculates a quantity difference to qualify for the business to business transaction and promotion, and displays the quantity difference along with business-to-business transaction and promotion information at the customer side display, and provides the customer side with an option of modifying the order"

(Mesaros: figures 4, 13, and 14. The feature of "modifying" is addressed by the rejections of claims 25 and 27-29; therefore the same rejections apply to this claim.).

Referring to claim 50, Mesaros teaches "displaying at the customer side, information reflecting the revised order that conforms to the selected promotion, whereby the initial order is no longer operative at the seller side" and "executing the revised order at the seller side". Rubin, in an analogous art, teaches "displaying at the customer side, information reflecting the revised order that conforms to the selected promotion, whereby the initial order is no longer operative at the seller side" (Rubin: abstract and figures 2-3) and "executing the revised order at the seller side" (Rubin: figure 3).

Referring to claim 53, Mesaros fails to teach "wherein said customer side terminal displays no promotion information and execute the initial order as entered when said quantity range is determined to be below said first predetermined quantity".(Mesaros: column 7 lines 1-31; where an order can be placed without conforming to said pricing schemes).

Referring to claim 54, Mesaros teaches "wherein said customer side terminal displays promotion information corresponding to a retail-customer-to-business transaction contingent on increasing the specified quantity of the initial order to at least

a second predetermined quantity higher than said first predetermined quantity”
(Mesaros: figures 4, 13, and 14).

Referring to claim 55, Mesaros teaches “wherein said customer side terminal displays promotion and transaction information corresponding to a retail-customer-to-business transaction when the specified quantity of the initial order is lower than said third predetermined quantity but higher than said first predetermined quantity (Mesaros: figure 4; where several pricing thresholds are disclosed).

Referring to claim 56, Mesaros teaches “wherein said customer side terminal displays promotion and transaction information corresponding to a business-to-business transaction contingent on increasing the specified quantity of the initial order to a fourth predetermined quantity.” (Mesaros: figure 4; where several pricing thresholds are disclosed).

Referring to claim 57, Mesaros teaches “wherein said customer side terminal displays promotion and transaction information corresponding to a business-to-business transaction when the specified quantity of the initial order is determined to be equal to or above said third predetermined quantity but below a fourth predetermined quantity”
(Mesaros: figure 4; where several pricing thresholds are disclosed).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan K. Deshpande whose telephone number is (571)272-5880. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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